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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,850	07/22/2003	Felix Bator	F-673	1866

7590

07/02/2004

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EXAMINER

COSIMANO, EDWARD R

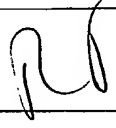
ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/626,850	Applicant(s) BATOR ET AL. 	
	Examiner Edward R. Cosimano	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>July 22, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.

3. The use of various trademark(s), for example: "E-Stamp®" and "Clickstamp™", have been noted in this application in:

A) paragraph number 6 on page 2, "The IBIP Specification defines a stand-alone open metering system, ... USPS was the E-Stamp® Internet Postage which was distributed by E-stamp Corporation of Houston, Texas.";

B) paragraph number 8 on pages 3-4, "The IBIP Specification defines this alternative ... a virtual meter is Clickstamp™ ... for further descriptions of virtual metering.";

C) paragraph number 26 on page 8, "Virtual postage metering system 10 ... Clickstamp™ ... the indicium is created and printed on the mailpiece.";

D) paragraph number 39 on pages 13-14, "In accordance with ... Clickstamp ... by providing the instant printing of PC postage evidencing.";

E) paragraph number 40 on page 14, "The present invention provides Clickstamp ... customer's PC has been loaded into the PC.";

F) paragraph number 42 on page 14, "Referring now to Fig. 6, ... Clickstamp ... the meter state is set to a disabled mode to prevent unauthorized use.";

G) paragraph number 43 on pages 14-15, "At step 304, ... Clickstamp ... Clickstamp™ ... Clickstamp™ ... new user access key is e- mailed to the customer.";

H) paragraph number 44 on page 15, "At step 308, ... Clickstamp ... Clickstamp ... the customer may begin dispensing postage.";

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I) paragraph number 46 on page 15, "At step 312, ... Clickstamp ... the transitioned meter in preparation for the next customer registration.";

J) paragraph number 47 on page 16, "An alternative to step 312, ... Clickstamp ... meter until required for another customer."; and

K) paragraph number 55 on page 18, "Clickstamp is a trademark of Pitney Bowes Inc.";

Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

3.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(4) because reference character "10" has been used to designate both the "postage metering system 10" (fig. 1 and paragraphs 24-27, 29 & 30 on pages 7-9) and to designate the "Network Service Provider" in figs. 2 & 4.

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description, note reference legend(s):

(a) 52 of fig. 2 as this figure is described in paragraph number 31 on page 10, "Referring now to Fig.2, in ... purpose of handling requests from a plurality of customers at one time.".

(b) 52 of fig. 4 as this figure is described in paragraph number 33 on page 11, "Referring now to Fig. 4, a ... determined by the vendor to adequately support the customers requesting postage.".

4.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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4.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

5. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data in paragraph number 1 on page 1; and

(2) the application data in:

(a) paragraph number 30 on page 9, "Instant virtual postage metering system 10 ... U.S. Patent Application Serial Number 09/242,206, ... assigned to the assignee of the present invention."; and

(b) paragraph number 49 on page 16, "In accordance with ... U.S. Patent Application Serial No. 09/474327 ... transaction from the customer's account on the micropayment system.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 52 of fig. 2 as this figure is described in paragraph number 31 on page 10, "Referring now to Fig.2, in ... purpose of handling requests from a plurality of customers at one time."; and

(b) 52 of fig. 4 as this figure is described in paragraph number 33 on page 11, "Referring now to Fig. 4, a ... determined by the vendor to adequately support the customers requesting postage.".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) it is noted that applicant has inconsistently used the trademark "Clickstamp™" with the symbol "™" in:

(a) paragraph number 8 on pages 3-4, "The IBIP Specification defines this alternative ... a virtual meter is Clickstamp™ ... for further descriptions of virtual metering.";

(b) paragraph number 26 on page 8, "Virtual postage metering system 10 ... Clickstamp™ ... the indicium is created and printed on the mailpiece."; and

(c) paragraph number 43 on pages 14-15, "At step 304, ... Clickstamp ... Clickstamp™ ... Clickstamp™ ... new user access key is e- mailed to the customer."; and

with out the symbol "™" in:

(a) paragraph number 39 on pages 13-14, "In accordance with ... Clickstamp ... by providing the instant printing of PC postage evidencing.";

(b) paragraph number 40 on page 14, "The present invention provides Clickstamp ... customer's PC has been loaded into the PC.";

(c) paragraph number 42 on page 14, "Referring now to Fig. 6, ... Clickstamp ... the meter state is set to a disabled mode to prevent unauthorized use.";

(d) paragraph number 43 on pages 14-15, "At step 304, ... Clickstamp ... Clickstamp™ ... Clickstamp™ ... new user access key is e- mailed to the customer.";

(e) paragraph number 44 on page 15, "At step 308, ... Clickstamp ... Clickstamp ... the customer may begin dispensing postage.";

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(f) paragraph number 46 on page 15, "At step 312, ... Clickstamp ... the transitioned meter in preparation for the next customer registration.";

(g) paragraph number 47 on page 16, "An alternative to step 312, ... Clickstamp ... meter until required for another customer."; and

(h) paragraph number 55 on page 18, "Clickstamp is a trademark of Pitney Bowes Inc.".

D) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Note:

(1) paragraph number 8 on pages 3-4, "The IBIP Specification defines this alternative version, ... at its web site www.nitnevworks.com. See ... for further descriptions of virtual metering.".

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. Claims 1-3 & 9-13 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 6,619,544 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

7.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) a remote device that receives a request for evidence of postage via a network; and

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B) the remote device processes the request to account for the used postage and produces evidence of postage payment.

7.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed

in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.1 Claims 1-2 & 9-12 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Shah et al (5,822,738).

8.1.1 In regard to claims 1-2 & 9-12, Shah et al ('738) as can be seen in fig. 6, in the environment or postage metering discloses secured metering device (SMD) 210 that has been licensed by the Postal Authority to store and dispenses postage. When a customer desires to print postage on an item of mail 100 using user general purpose printer 60 connected to customer general purpose PC 20, the user at PC 20 creates a request for postage that includes the at least an identification of the customer, the originating location, the postage value, class of service, destination zip code, piece count or transaction number, as well as any other information require to determine the correct postage for an item of mail 100. Next the generated request for postage is transmitted to remotely located SMD 210 via a suitable communications network, where SMD 210 uses the transmitted information to:

A) account for the requested postage in a single general account or an account for the user; and

B) to generate a print file of a valid postage indicia that includes encode information as evidence of postage payment.

The print file is then transmitted to identified user PC 20 via a suitable communications network and printed on item of mail 100 by user using printer 60.

8.2 Claims 1-3 & 9-13 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Kara (5,822,739).

8.2.1 In regard to claims 1-3 & 9-13, Kara ('739) as can be seen in fig. 1, in the environment or postage metering discloses postage server 10 that is connected to metering device 14 that has been licensed by the Postal Authority to store and dispenses postage. When a customer desires to print postage on an item of mail using user general purpose printer 24 connected to

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customer general purpose PC 20, the user at PC 20 creates a demand for postage that includes the at least an identification of the customer, the originating location, the postage value, class of service, destination zip code, piece count or transaction number, as well as any other information require to determine the correct postage for an item of mail. Next the generated demand for postage is transmitted to remotely located metering device 14 via a suitable communications network, where server 10 and device 14 uses the transmitted information to:

A) account for the requested postage in a single general account or an account for the user; and

B) to generate a valid postage indicia that includes encode information as evidence of postage payment.

The generated indicia is then transmitted to identified user PC 20 via a suitable communications network and printed on the item of mail by user using printer 24.

8.2.2 In regard to claims 3 & 13, the user of Kara ('739) gains access to the system by using a ID and password.

8.3 Claims 1-3 & 9-13 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Whitehouse (6,005,945).

8.3.1 In regard to claims 1-3 & 9-13, Whitehouse ('945) as can be seen in fig. 4, in the environment or postage metering discloses postage server 102 that performs postage metering functions and has been licensed by the Postal Authority to store and dispenses postage. When a customer desires to print postage on an item of mail using user general purpose printer 108 connected to customer general purpose PC 104, the user at PC 104 creates a request for postage that includes the at least an identification of the customer, the originating location, the postage value, class of service, destination zip code, piece count or transaction number, as well as any other information require to determine the correct postage for an item of mail. Next the generated request for postage is transmitted to remotely located postage server 102 via a suitable communications network, where server 102 uses the transmitted information to:

A) account for the requested postage in a single general account or an account for the user; and

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B) to generate a valid postage indicia that includes encode information as evidence of postage payment.

The generated indicia is then transmitted to identified user PC 104 via a suitable communications network and printed on the item of mail by user using printer 108.

8.3.2 In regard to claims 3 & 13, the user of Whitehouse ('945) gains access to the system by using a ID and password.

8.4 Claims 1-2 & 9-12 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Heiden et al (6,141,645).

8.4.1 In regard to claims 1-2 & 9-12, Heiden et al ('645) as can be seen in figs. 1 & 3, in the environment or postage metering discloses postage evidencing device (PED) 208 that has been licensed by the Postal Authority to store and dispenses postage. When a customer desires to print postage on an item of mail 20 using user general purpose printers 120,130 connected to customer general purpose PC 150, the user at PC 150 creates a request for postage that includes the at least an identification of the customer, the originating location, the postage value, class of service, destination zip code, piece count or transaction number, as well as any other information require to determine the correct postage for item of mail 20. Next the generated request for postage is transmitted to remotely located PED 208 via a suitable communications network, where PED 208 uses the transmitted information to:

A) account for the requested postage in a single general account or an account for the user; and

B) to generate a valid postage indicia that includes encode information as evidence of postage payment.

The print file is then transmitted to identified user PC 150 via a suitable communications network and printed on the item of mail by user using printer 120,130.

8.5 Claims 1-2 & 9-12 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Shah et al (2003/0078893).

8.5.1 In regard to claims 1-2 & 9-12, Shah et al ('893) as can be seen in fig. 1, in the environment or postage metering discloses secured metering device (SMD) 126 that has been licensed by the Postal Authority to store and dispenses postage. When a customer desires to

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print postage on an item of mail 174 using user general purpose printer 170 connected to customer general purpose PC 140, the user at PC 140 creates a request for postage that includes the at least an identification of the customer, the originating location, the postage value, class of service, destination zip code, piece count or transaction number, as well as any other information require to determine the correct postage for an item of mail 174. Next the generated request for postage is transmitted to remotely located SMD 126 via a suitable communications network, where SMD 126 uses the transmitted information to:

A) account for the requested postage in a single general account or an account for the user; and

B) to generate a print file of a valid postage indicia that includes encode information as evidence of postage payment.

The print file is then transmitted to identified user PC 140 via a suitable communications network and printed on item of mail 174 by user using printer 170.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10. The examiner has cited prior art of interest, for example:

A) Racanelli (4,511,793), which discloses a single postage meter (C) that use funds stored in a general account to print postage for a number of users/departments, where a code 12 is used to identify each user of the postage meter and to account for the use of the funds stored in the general account by each user.

B) Eckert (4,649,266), which discloses that a postage indicia 10 contains the point of origin "Norwalk Conn 06851", postage amount 12, an identification of the postage meter in meter serial number 14, date 15, and piece count or transaction number 18.

C) Le Carpentier (4,752,950), which discloses the remote control and monitoring of a number of franking machines.

D) Taylor et al (4,812,994), which discloses a postage metering system which cooperates with user's computers to dispense postage and in which user must use user Ids and passwords to gain access to the postage meter.

E) Sansone et al (4,837,701) in which a vender or central station purchase postage from the post office and then based on a purchase request by an authorized mailer dispenses postage from a central station to the mailer.

F) Bransten, which discloses that a PC may be used to obtain postage over the Internet.

G) Gravell et al (WO 98/57303) which discloses a remote postage metering system which cooperates with user's computers to dispense postage that originates from a number of different origins of deposit.

11. Applicant must supply the draft specification mentioned in:

A) paragraph number 5 on pages 2-3, "Recently, the United States Postal Service ... IBIP PERFORMANCE CRITERIA FOR INFORMATION-BASED INDICIA AND SECURITY ARCHITECTURE FOR OPEN IBI POSTAGE METERING SYSTEMS (PCIBI-O), a published draft specification dated February 23, 2000, ... IBIP, requirements for a host system element (personal computer of IBIP).";

B) paragraph number 7 on page 3, "The USPS has approved an alternative version ... in IBIP PERFORMANCE CRITERIA FOR INFORMATION-BASED INDICIA PROGRAM (IBIP) SYSTEMS EMPLOYING CENTRALIZED POSTAL SECURITY DEVICES, a published draft specification dated August 17, 2000, which is referred to herein as the "IBIP Centralized Specification".";

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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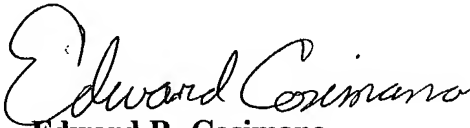
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

06/21/04


Edward R. Cosimano
Primary Examiner A.U. 3629